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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,433	06/12/2001	Robert J. Crowley	BSC-009DV	4101

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EXAMINER

SHAY, DAVID M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879433

Applicant(s)

Crowley

Examiner

J. Shay

Group Art Unit

3729

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on February 2, 2004.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 14-40 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 14-40 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

In view of the Brief or Appeal filed on February 2, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 14-18, 21, 22, 25, 27, 28, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selman et al in combination with Clarke. Selman et al teach a method such as claimed except for the use of a flash lamp. Clarke teaches an irradiation method and teaches the equivalence of lasers and flash lamps. It would have been obvious to the artisan of ordinary skill to employ the flash lamp of Clarke in the method of Selman et al, since this is equivalent a laser, as taught by Clarke and since Selman et al teach that any of a variety light sources can be used, thus producing a method such as claimed.

Claims 14, 19 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in combination with Clarke. Anderson et al teach the desirability of using light to ablate the endometrium, but does not teach using a flash lamp. Clarke teaches the use of a flash lamp to irradiate tissue. It would have been obvious to the artisan of ordinary skill to employ a flashlamp as the light source in the method of Anderson et al, since these are equivalent to lasers, as taught by Clarke thus producing a method such as claimed.

Claims 20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selman et al in combination with Clarke as applied to claims 14-18, 21, 22, 25, 27, 28, 39 and 40 are above, and further in view of Waksman et al. Waksman et al teach the applicability of treatments of blood vessels and bladder surfaces to the surface of the urethra. Thus it would have been obvious to the artisan of ordinary skill to employ the combined method of Clarke and Selman et al on any of the tissues of Waksman et al, since these are equivalents, as taught by Waksman et al, thus producing a method such as claimed.

Claims 25, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selman et al in combination with Clarke as applied to claim 25 above, and further in view of Waksman et al and Spears et al. The teachings of Waksman et al and the motivations for combination thereof are as set forth above. Spears et al teach employing a balloon enclosing the light emitters and placing a fluid therein to transfer heat. It would have been obvious to the artisan of ordinary skill to employ the teachings of Waksman for the reasons set forth above and

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to employ the balloon and fluid of Spears et al, since this will better enable the energy to reach the tissue to be treated, thus producing a method such as claimed.

Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in combination with Clarke as applied to claim 14 above, and further in view of Ohtake. Ohtake teach the use of a lenticular surface with a flash lamp. It would have been obvious to the artisan of ordinary skill to employ a lenticular surface in the method of Anderson et al in combination with Clarke, since this would provide a more even distribution of light, thus producing a method such as claimed.

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selman et al in combination with Clarke as applied to claim 14 above, and further in view of Feinbloom. Feinbloom teaches a flash lamp circuit that uses a transformer to step up the voltage. It would have been obvious to the artisan of ordinary skill to employ a transformer to step up the voltage, since this provides a bright light, as taught by Feinbloom, and is standard in flash lamp activating circuits, official notice of which is hereby taken, thus producing a method such as claimed.

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selman et al in combination with Clarke and Feinbloom as applied to claims 33 and 34 are above, and further in view of Staton. Staton teaches the use of a foil as a triggering electrode for a flash lamp. It would have been obvious to the artisan of ordinary skill to employ the triggering

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electrode as taught by Staton, since this would help provide a more evenly distributed flash, thus producing a method such as claimed.

Regarding applicants arguments, to the extent they still apply, one having ordinary skill in the art would be motivated to employ the flash lamp of Clarke in the method of e.g. Selman et al because they are equivalent to lasers, as taught by Clarke and as also more economical to purchase and operate, official notice of which is hereby taken. Regarding Waksman et al, the desirability of treating the various tissues taught by Waksman still ablative, the particular modality of Waksman et al notwithstanding.

Applicant's arguments with respect to claims 31-36 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.



**DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330**

Shay/DL

April 21, 2004